

AUS920010422US1

REMARKS

Claims 1-20 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Pool, U.S. 6,460,020, either in view of Well Known Prior Art or in view of Seigel, U.S. 2001/0051876. The Office Action on page 7 states, regarding respective custom planning records each individually comprising all of the specific data elements as claimed:

However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have arranged any of the calculated and stored data elements of Pool, *et al.* so as to be stored in a specific arrangement/manner of the instant claims, simply as a matter of design choice, since so doing could have been performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

The ordinary skill so described is referred to in this Response as 'Well Known Prior Art.' Applicants understand, based on this language from the Office Action, that this rejection, based on 'ordinary skill' so described, is a rejection relying on common knowledge or Well Known Prior Art according to MPEP 2144.03. As will be shown below, however, Pool, neither alone or nor in combination, teaches or suggests a method, system, or computer program product for facilitating customs planning and clearance as claimed in the present application. Claims 1-20 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-20.

Claim Rejections – 35 U.S.C. § 103

To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed.

AUS920010422US1

Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Pool and Well Known Prior Art

Claims 1-6 and 11-20 stand rejected under 35 U.S.C § 103(a) as unpatentable over Pool in view of Well Known Prior Art. Claims 7-10 stand rejected under 35 U.S.C § 103(a) as unpatentable over Pool in view of Seigel. Both rejections rely on Pool for disclosure or suggestion of several elements of Claim 1, whereas in fact, Pool does not disclose or suggest those elements. Neither proposed combination therefore can establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claims of the present application, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The Office Action Fails To Provide The Applicants With Information Sufficient To Judge The Propriety Of Continuing Prosecution As Required By 35 USC 132

35 USC 132 requires the Examiner to notify the applicants of the reasons for a rejections, including "such information and references as may be useful in judging of the propriety of continuing the prosecution" 37 CFR 1.104(c)(2) second sentence requires, "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." MPEP 707 requires, when needed for compliance with 35 USC 132, the inclusion in the Office Action of "... the particular figures(s) of the drawing(s), and/or page(s) or

AUS920010422US1

paragraph(s) of the reference(s)" MPEP 707.07(d) warns against omnibus rejections as, "... stereotyped and usually not informative and should therefore be avoided."

The Office Action at page 7 sets forth the following omnibus rejection of most of the elements of claim 1 over Pool:

Regarding claims 1, 2, 12, and 13, Pool et al disclose a method for facilitating customs planning and clearance, the method comprising the steps of: creating a master customs planning record and a related customs planning record in at least one international customs server, in response to signals communicated through a client device coupled for data communications through at least one Internet connection to the at least one international customs server, and the method of Pool et al. includes, either inherently or explicitly, calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise ...

This reference to Pool in the Office Action makes no mention of where in Pool the information relied on by the Examiner may be found. Pool describes, among other things:

- international shopping operations
- carrying out an international commercial transaction
- selecting a language from a menu in which to view catalog information on products
- selecting a currency from a menu in which to obtain price information
- selecting a product to be purchased and a destination for shipping such product to be purchased

AUS920010422US1

- accessing at least one local or remote database for obtaining price information for the product to be purchased
- product codes for an international goods classification system
- international shipping information related to origination points of products and destinations
- receiving an order for products thereby triggering an electronic process for confirming existence of available funds
- accepting orders upon confirmation of availability of funds
- using customer information to select a currency and determining an exchange rate based upon the determined currency and a predetermined exchange medium
- determining whether the product to be purchased in fact involves an international transaction
- determining a shipping route and calculating associated costs
- arranging for shipment of a product along a shipping route selected by a customer
- correlating movement of an electronic record with movement of a product along a selected shipping route.
- generating documents from an electronic record when appropriate along a selected shipping route

AUS920010422US1

- authorizing electronic payment of expenses required along a selected shipping route
- storing and analyzing data based upon each customer accessing the system to develop a purchasing profile for each customer
- using a customer's purchasing profile to select a candidate product to be presented to the customer

Clearly Pool is a complex reference containing information regarding many technical subjects and other inventions. In this circumstance, it is important for the Examiner to provide some indication of where in Pool the Examiner believes elements of Applicants' claims to be disclosed or suggested in order for Applicants to have enough information to judge how or whether to continue the prosecution of the present application. Moreover, in the absence of any indication of where within Pool the Examiner believes elements of Applicants' claims to be disclosed or suggested, Applicants cannot understand the reasons for the rejections.

For these reasons alone, the rejection of the claims should be withdrawn, and the claims should be allowed. Nevertheless, in an effort to move the case forward and without prejudice to their request that the rejections should be withdrawn, Applicants undertake to make their best guess regarding the meaning of the Office Action and respond below as best they can under the circumstances.

Neither Proposed Combination With Pool
Teaches The Asserted Claim Limitations

As mentioned above, the Office Action at page 7, regarding Pool, states:

Regarding claims 1, 2, 12, and 13, Pool et al. disclose a method for facilitating customs planning and clearance, the method comprising the steps of: creating a

AUS920010422US1

master customs planning record and a related customs planning record in at least one international customs server, in response to signals communicated through a client device coupled for data communications through at least one Internet connection to the at least one international customs server, and the method of Pool et al. includes, either inherently or explicitly, calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise ...

As mentioned above, it is not possible to know from the Office Action how or why the Examiner believes that Pool anticipates these elements of facilitating customs planning and clearance as claimed in the present application. What Pool in fact discloses is a "UNIVERSAL SHOPPING CENTER FOR INTERNATIONAL OPERATION." Pool, Title Block (54). (All the following references are to Pool.) The principal object of Pool is described in column 2, lines 60-63 as:

... to consolidate all the disparate components of an international sale into one program whereby a buyer can go shopping by computer almost anywhere in the world.

In fact, the overall message of Pool is that of a purchasing system. The introduction of the Detailed Description in Pool at column 3, lines 60-66, states, for example:

The design of the international shopping and transaction system of the present invention creates a seamless order entry system for shopping ... for both national and international transactions for the purchase of goods and services.

For further examples of Pool's disclosure of a purchasing system, please consider the following excerpts:

AUS920010422US1

- In particular, the present invention is directed to the facilitation of international purchasing of goods ... addressing all aspects of such transactions. (column 1, lines 11-13, describing the TECHNICAL FIELD of Pool)
- customer information, including credit and financial data, as well as purchasing records and profiles (column 4, lines 18-19)
- A foreign vendor whose products are about to be purchased by the customer could be paid through an electronic clearing house that has received clearance from the clearing house in the customer's country. (column 10, lines 3-7)
- Such information can later be used to guide customers to catalogues or products related to previous purchases, as well as previously selected languages and currencies. (column 12, lines 5--53)
- Further, by providing an electronic title as the commercial invoice, the documentation flow is facilitated, costs reduced and the customer receives proof of purchase in a more timely fashion. (column 12, lines 64-68)
- Therefore until a pattern of purchases of like goods or services is defined between the two parties or geographic regions each transaction is unique in and unto itself. (column 13, lines 36-39)
- Our example will be a new automobile purchased from a local dealer by an export company for resale to a buyer located in the Netherlands. (column 14, lines 19-21)

Clearly Pool discloses a purchasing system having little or nothing to do with facilitating customs planning and clearance as claimed in the present application. As further evidence of the lack of disclosure or suggestion in Pool regarding facilitating customs planning and clearance as claimed in the present application, please note that not one of

AUS920010422US1

the following terms or phrases from claim 1 of the present application occurs anywhere in Pool, not even once:

- facilitating customs planning
- facilitating customs planning and clearance
- customs planning record
- master customs planning record
- related customs planning record
- international customs server
- signals communicated through a client device

Clearly in these circumstances there is no sound basis for believing that Pool in any way discloses or suggests elements of the claims in the present application. For this reason alone, the rejections under 35 USC 103(a) should be withdrawn, and the claims should be allowed.

The Theory of Inherency Is Not Available As A
Basis For Rejection Of Claims In The Present Case

The Office Action at page 7, regarding Pool, states:

... and the method of Pool et al. includes, either inherently or explicitly, calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise ...

AUS920010422US1

That is, the Office Action invokes the theory of inherency as a basis for rejection of elements of claim 1 in the present application. The Office Action takes the position in effect that some disclosure in Pool necessarily results in the claim elements recited above, calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise The rejection, however, is not accompanied by the required analysis to support a rejection relying on inherency. Merely reciting the word "inherently" is insufficient basis for a rejection on the theory of inherency. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) cited in MPEP § 2112. The Office Action does not demonstrate in any way that anything in Pool necessarily results in calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise. In fact, such inherency does not exist. Calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise . . . cannot properly be said to necessarily flow from any of the teaching in Pool within the meaning of *Levy*. For this reason alone, Pool can be seen to not disclose or suggest the claim elements asserted on its behalf. For this reason alone, claim 1 is patentable and should be allowed.

Well Known Prior Art Is
Not Available As A Reference

The Office Action on page 7 states, regarding respective custom planning records each individually comprising all of the specific data elements as claimed:

However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have arranged any of the calculated and stored data elements of Pool, *et al.* so as to be stored in a specific arrangement/manner of the instant claims, simply as a matter of design choice, since so doing could have

AUS920010422US1

been performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

The ordinary skill so described is referred to in this Response as 'Well Known Prior Art.' Applicants understand, based on this language from the Office Action, that this rejection, based on 'ordinary skill' so described, is a rejection relying on common knowledge or Well Known Prior Art according to MPEP 2144.03. Applicants respectfully propose, however, that 'arranged any of the calculated and stored data elements of Pool, *et al.* so as to be stored in a specific arrangement/manner of the instant claims' is not available to the Examiner in this case as Well Known Prior Art.

According to MPEP § 2144.03, the Examiner may make use of Well Known Prior Art facts outside the record only if such facts are capable of instant and unquestionable demonstration as being well-known in the art. Well Known Prior Art, however, may not be substituted for facts which cannot be instantly and unquestionably demonstrated. As indicated in In re Lee, 277 F.3d at 1343-44, 61 USPQ at 1433-34, the examiner's finding of whether there is a teaching, motivation or suggestion to combine the teachings of the applied reference must not be resolved based on "subjective belief and unknown authority," but must be "based on objective evidence of record." The court in Lee requires evidence for the determination of unpatentability by clarifying that "common knowledge and common sense," as mentioned in In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969), may only be applied to analysis of the evidence, rather than be a substitute for evidence. Lee, 277 F.3d 1345, 61 USPQ2D at 1435.

In this case, Applicants note with respect that the Examiner has made a mere naked assertion that a fact is well known in the prior art with absolutely no "objective evidence of record" and no expression of any reason why one having ordinary skill in the pertinent art would have been led to modify the prior art to arrive at the claimed invention. As mentioned, Well Known Prior Art may not be substituted for facts which cannot be instantly and unquestionably demonstrated. For these reasons, the Examiner in this case cannot have recourse to facts well known in the prior art and this rejection therefore fails

AUS920010422US1

to establish a prima facie case of obviousness. Claims 1 is therefore patentable and should be allowed.

No Suggestion or Motivation to Modify Pool

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Pool. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to modify Pool must come from the teaching of the cited art itself, and the Examiner must explicitly point to the teaching within the cited art suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.,2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

In this case, the Office Action makes no mention whatsoever of any evidence of suggestion or motivation to modify Pool, neither in Pool itself nor in Well Known Prior Art nor in Seigel. As such, no proposed modification of Pool can establish a prima facie case of obviousness. For this reason, the rejection of claim 1 should be withdrawn, and claim 1 and all claims depending from it should be allowed.

Pool Teaches Away From Facilitating Customs Planning
And Clearance As Claimed In The Present Application

Pool actually teaches away from Facilitating Customs Planning And Clearance as claimed in the present application. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). The

AUS920010422US1

present application claims a method of facilitating customs planning and clearance. Pool in contrast teaches a process for carrying out an international commercial transaction (column 17, lines 2-3) that makes no mention whatsoever of facilitating customs planning and clearance as claimed in the present application – thereby teaching directly away from facilitating customs planning and clearance as claimed in the present application. Because Pool teaches away from facilitating customs planning and clearance as claimed in the present application, the proposed modification of Pool by Well Known Prior Art cannot support a prima facie case of obviousness.

No Reasonable Expectation of Success in the
Proposed Combination of Pool and Well Known Prior Art

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Pool. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There can be no reasonable expectation of success in a proposed modification if the proposed modification changes the principle of operation of Pool. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

There can be no reasonable expectation of success in a proposed combination of process for carrying out an international commercial transaction of Pool with the ‘arranged any of the calculated and stored data elements of Pool, *et al.* so as to be stored in a specific arrangement/manner of the instant claims’ as Well Known Prior Art to produce facilitating customs planning and clearance as claimed in the present application. On the contrary, incorporating ‘arranged any of the calculated and stored data elements of Pool, *et al.* so as to be stored in a specific arrangement/manner of the instant claims’ upon the process for carrying out an international commercial transaction of Pool would clearly change the principle of operation of Pool – changing it from a process for carrying out an international commercial transaction to a method of facilitating customs planning and clearance. That is, the principle of operation of Pool, carrying out an international commercial transaction, is changed completely, and in fact will not function at all, with the addition of the exact arrangement of data elements as claimed in claim 1 and alleged

AUS920010422US1

to be Well Known Prior Art. The proposed modification of Pool by Well Known Prior Art therefore cannot possibly support a prima facie case of obviousness.

Restriction Requirement Made Final

Applicants acknowledge with gratitude the Examiner's advice in paragraph 13 of the Office Action that Applicants timely traversed the restriction requirement in this case in an election submitted August 17, 2004. Applicants further acknowledge the Examiner's making the restriction requirement final in paragraph 12 of the Office Action. Applicants respectfully reserve the right to petition the Commissioner for review of the restriction requirement in accordance with 37 CFR 1.144.

Relations Among Claims

Claim 1 is allowable for the reasons set forth above. Claims 2-20 depend from independent claim 1. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because Pool does not disclose or suggest the independent claim elements asserted for it in the Office Action, neither Pool nor any combination with Pool can possibly disclose or suggest each and every element of any dependent claim. The rejections of Claims 1-20 therefore should be withdrawn, and these claims also should be allowed.

AUS920010422US1

Conclusion

Claims 1-20 stand rejected under 35 U.S.C § 103 as being obvious over Pool in view of Well Known Prior Art or Seigel. Neither Pool nor Pool in any combination discloses nor suggests each and every element of Applicants' claims. Claims 1-20 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 1-20.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: 05-08-05

By:



John Biggers
Reg. No. 44,537
Biggers & Ohanian, LLP
504 Lavaca Street, Suite 970
Austin, Texas 78701
Tel. (512) 472-9881
Fax (512) 472-9887
ATTORNEY FOR APPLICANTS